The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARIE-CHRISTINE ETIENNE

Appeal No. 2005-0793
Application No. 09/839,366

ON BRIEF

Before ELLIS, SCHEINER and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is remanded to the examiner to clarify the status of the rejection under 35 U.S.C. § 103 over Labrecque and Tatau in view of appellant's admissions on the record.

We first note that the examiner does not list the Labrecque reference in Section 9 of the Examiner's Answer, Prior Art of Record. Secondly, we could not locate a copy of that reference in our review of the IFW file. Thirdly, listed on both the Information Disclosure Statement submitted by appellant, dated April 23, 2001, and the Notice of References Cited provided by the examiner, dated December 18, 2001, is a reference to Labreque (the Information Disclosure

Statement) and Labrequie (Notice of References Cited) which appears to be a Biosis abstract. In the Examiner's Answer, however, the examiner cites to page 1751, column 1, paragraph 1 of Labrecque, making it unclear whether the examiner is relying on the abstract only or on the reference in its entirety.[1]

Accordingly, upon receipt of the application and before return to the Board for a decision on the merits, the examiner must obtain a complete copy of the Labrecque reference, make it of record, provide a copy to appellant, and have the complete copy scanned into the IFW file.[2]

The panel would also like to take this opportunity to raise additional issues that the examiner and appellant should consider before the case is returned to the Board for a decision on the merits.

First, the examiner should consider whether the claims meet the requirement of 35 U.S.C. § 112, first paragraph, written description—that is, whether the claims contain subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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[1] We note that "[c]itation of and reliance upon an abstract is generally inappropriate where both the abstract and the underlying document are prior art." MPEP §706.02 (II) (8th edition, Revision 2, May 2004). Moreover, in order for meaningful appellate review to occur, the examiner must present a full and reasoned explanation of the rejection see, e.g., In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002), and that would include analysis of the full underlying document.

[2] The panel also notes that this appeal was remanded to the examiner on April 11, 2005, to have the Tetau, Petit, Cazin and Besnouin references, as well as a translation of the Clairet reference, scanned into the IFW file, as well as "such further action as may be appropriate." At that time, the examiner should have ensured that all of the references being relied upon were part of the IFW file.

In Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 63 USPQ2d 1609 (Fed. Cir. 2002), the Federal Circuit adopted a portion of the Guidelines proffered by the United States Patent and Trademark Office (USPTO). The court stated that:

> The written description requirement can be met by "showing that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics . . . i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of characteristics."

Enzo Biochem, 323 F.3d at 964, 63 USPQ2d at 1613 (citing Guidelines for Examination of Patent Applications Under the 35 U.S.C. § 112, ¶ 1 "Written Description Requirement, 66 Fed. Reg. 1099, 1106 (January 5, 2001)).

In University of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916, 69 USPQ2d 1886, (Fed. Cir. 2004) the Court of Appeals for the Federal Circuit held that claims drawn to methods of inhibiting PGHS-2 activity by administering a non-steroidal compound that inhibits activity of prostaglandin H synthase-2 were invalid for failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. See 358 F.2d at 917-18, 69 USPQ2d at 1887-88.

The University of Rochester court made clear that cases such as Enzo do not apply only to claims to genetic material, as the written description requirement applies to all types of inventions. See 358 F.2d at 925, 69 USPQ2d at 1893-94. Moreover, while disclosure of a DNA sequence may support claims to complementary molecules that can hybridize to it due to the complementarity of genetic material, "[t]he same is not necessarily true of the chemical arts more

generally." See id. Thus, "[a] description of what a material does, rather that of what it is, normally does not suffice." See 358 F.2d at 923, 69 USPQ2d at 1892 (citation omitted).

Claim 1 is drawn to:

A method for causing the elimination of an active principle, R, from cells of a mammal which contain the active principle, R, which comprises administering to said mammal, a compound identical in nature to said active principal in a homeopathic product of the formula RxCH, in which R is the active principle and in which xCH is a homeopathic dilution of said active ingredient R to eliminate R from the cells to restore normal function to the perturbed pericellular transport systems.

The disclosure teaches that:

> The metabolic diseases to which the invention relates are diseases characterized by the intracellular accumulation or intracellular deficit of a chemical substance of simple or complex formula, which can vary from case to case and is designated here by R.
>
> In fact, R acts on pericellular transport systems with respect to itself, which systems have broken down and to which it restores correct function. These diseases are frequently referred to as genetic in the prior art.

Specification, page 2.

The disclosure further teaches that R can be, in the case of cystic fibrosis, without limitation, NaCl, see id. at 6; in the case of pigmentary retinopathy, R may be melanin or sepia, see id.; in the case of oxalosis, R may be oxalic acid or calcium oxalate, see id.; in the case of hyperkalemic periodic paralysis, R may be potassium or a potassium salt, see id. at 6-7; in the case of hemochromatosis, R may be iron, see id. at 7; in the case of Wilson's disease, R may be copper, see id.; in the case of Alzheimer's disease, R may be aluminum or an aluminum salt, see id.; in the case of tetany, R may be dimagnesium phosphate, tricalcium

phosphate, or other salts or chemical substances see id. at 7-8; in the case of vitamin-resistant rickets, R may be calcium or mineral salts derived from calcium Calcarea carbonica, oyster limestone, or tricalcium phosphate, see id. at 8; in the case of anemia, R may be iron, see id.; in the case of rheumatoid polyarthritis, R may be black antimony sulfide in the juvenile case, and for the adult case, fluoric acid and graphites, see id. at 9; in the case of systemic lupus erythermatosus, R may be gold, see id.; in the case of amyotrophic lateral sclerosis, R may be phosphorus or a phosphorus salt, see id.; in the case of multiple sclerosis, R may be a salt derived from phosphorus, such as calearea phosphorica with another salt, causticum, see id.; in the case of hyperthyroidism, R may be sodium chloride (NaCl), see id. at 9-10.

The specification teaches further that:

> Finally, the following complaints may be mentioned as other examples of metabolic diseases, without implying a limitation: Refsum's disease, or R can be phytanic acid, Charcot-Marie-Tooth and Dejerine-Sottas disease, Huntington's chorea, where R can be zinc, Thevenard's disease, Friedrich's disease, Pierre Marie's hereditary cerebellar ataxia, Strumpell Lorrain's periodic paralysis, Roussy-Levys syndrome, dyslipidosis, idiopathic mental retardation [ ] in children, and autism.

Id. at 10.

Thus, as can be seen from the above portions of the disclosure, R can be almost anything, and be used to treat almost any complaint. The disclosure does not set forth any functional or structural relationship between what may be used as R and the abnormalities that may be treated.

Second, the examiner should also consider whether claims 21 and 22 meet the requirements of 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph.

Claim 21 is the independent claim, and is drawn to:

> Application of homeopathic compounds of the general formula RxCH to the elimination of an intracellular chemical substance R from the cell, when this elimination causes the restoration of normal function to the perturbed pericellular transport systems, in order to obtain drugs which, by causing this elimination from the cell are intended for restoring normal function to the perturbed pericellular transport system.

Claim 21 reads as a "use" claim, wherein the term "application" has been substituted for the term "use." Claim 21 is not drawn to a composition, nor is it drawn to a process, as it merely recites an "application" without any active, positive, process steps. See MPEP § 2173.05(q) (8th ed., August 2001, 2nd Revision, May 2004).

FUTURE PROCEEDINGS

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

JOAN ELLIS
Administrative Patent Judge

TONI R. SCHEINER
Administrative Patent Judge

LORA M. GREEN
Administrative Patent Judge

) BOARD OF PATENT APPEALS AND INTERFERENCES

LMG

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